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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,798

09/05/2003

Peter Jones

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07/09/2009

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EXAMINER

RANKINS, WILLIAM E

ART UNIT

PAPER NUMBER

3696

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,798	Applicant(s) JONES ET AL.	
	Examiner WILLIAM E. RANKINS	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 32-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/18/2003, 01/12/2004, 05/13/2004 and 03/27/2007 were filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Status of Claims

Claims 1-18 and 32-39 are pending in this application. Claims 1, 32 and 35-37 have been amended and claims 38 and 39 are new.

Response to Arguments

1. Applicant's arguments with respect to claims 1-18 and 32-39 have been considered but are moot in view of the new ground(s) of rejection.

A review of the claims and updated search necessitated the rejections below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-18 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lilly et al. (2002/0156723) in view of The fight for retail credit Jason Fargo. Credit Card Management. New York: Dec 2000. Vol. 13, Iss. 9, Retail cards seek wallet share, *Kenneth L Tye*. Chain Store Age. New York: Feb 2001. Vol. 77, Iss. and Official Notice.

As per claim 1;

Lilly discloses:

A method, comprising:

selecting a private label account maintained on a first processing platform for upgrade to a dual card account (Para. 0032), said private label account associated with an account holder (Abstract) and having associated monetary (Para. 0032, main credit limit) and non-monetary data (Para. 0053 customer profiles);

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determining that the account holder agrees to terms associated with the dual card account (Para. 0045);

Lilly does not specifically disclose:

creating said dual card account with a zero balance on a second processing platform in response to the determining that the account holder agrees to the terms; extracting the associated monetary and non-monetary data from a private label database;

transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account;

causing a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated; and

transferring said monetary data associated with said private label account to said second processing platform for association with said dual card account.

However, Fargo discloses:

Sears moving some 7 million inactive cardholders from it's proprietary card to Sears MasterCards (Pg. 2, 1st Para.). The examiner asserts that an inactive card is a card which does not carry a balance. Any dual card created from a previously inactive proprietary card would necessarily be created with a zero balance. In addition, the process of moving customers from a proprietary card to a co branded card would necessarily require the creation of the dual card on another platform, being that of the general purpose issuer.

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Tye further discloses:

Retailers outsourcing private label and dual card accounts (Pg. 1, Para. 2 and Pg. 2, Para. 3) as further evidence of a retailers desire to move cardholder data to a second platform.

The examiner takes Official Notice that the issuance and activation of credit cards, including dual cards was old and well known in the art at the time of this invention. This fact is evidenced by Lilly (Para. 0009) and by Gillin (Col. 18, lines 40-45) and Phillips et al. (7,130,828, claim 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Lilly, Fargo, Tye and Examiner's Official Notice. The examiner notes that MPEP 2143.01 IV states;

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). **>

The MPEP goes on to state;

[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR, 550 U.S. at ___, 82 USPQ2d at 1396 quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).<

As per claim 2;

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Lilly discloses:

The method of claim 1, wherein said selecting a private label account for upgrade further comprises:

receiving a conversion request from said cardholder, said request received by at least one of: a front line associate; an interactive voice response unit; and a Web site (Para. 0115).

Claims 3 and 4 are rejected under the same rationale used to reject claim 1.

As per claim 5;

Lilly does not disclose:

The method of claim 1, further comprising:
receiving an activation request from said account holder;
confirming that said account holder remains eligible for said dual card account; and
activating said dual card account.

However, the examiner takes Official Notice that it was old and well known in the art at the time of this invention to perform the steps above as noted in the disclosure of Brake, Jr. et al. (6,032,136, Col. 3, lines 29-54 and Col. 8, lines 16-23). The examiner asserts that the above method is performed as basic risk mitigation procedures.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Lilly, Fargo, Tye and Examiner's Official Notice. The examiner notes that MPEP 2143.01 IV states;

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A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). **>

The MPEP goes on to state;

[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR, 550 U.S. at ___, 82 USPQ2d at 1396 quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).<

Claim 7 is rejected under the same rationale used to reject claim 1.

As per claim 8;

Lilly discloses:

The method of claim 7, further comprising:

initiating a trailing activity process to identify monetary and non-monetary activity associated with said private label account (Para. 0117).

Claims 9, 10, 38 and 39 are rejected under the same rationale used to reject claim 8.

As per claim 11;

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Lilly discloses:

The method of claim 1, wherein said selecting further comprises:
updating a status flag associated with said private label account to indicate that said account has been selected for said conversion to said dual card account (Para. 0117).

As per claim 12;

Lilly discloses:

The method of claim 4, further comprising:
determining that said account holder has not declined said opportunity by
determining that a time period for declining said opportunity has expired (Para. 0052).

As per claim 13;

Lilly discloses:

The method of claim 1, wherein said private label account is identified by a private label account identifier and said dual card account is identified by a dual card account identifier, the method further comprising; generating a table including a cross-reference between said private label account identifier and said dual card account identifier (Para. 0049).

Claim 14 is rejected under the same rationale used to reject claim 1.

As per claim 15;

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Lilly discloses:

The method of claim 14, wherein said generating account information further comprises generating a rate associated with said dual card account (Para. 0050).

Claim 16 is rejected under the same rationale used to reject claim 1.

As per claim 17;

Lilly does not disclose:

The method of claim 16, wherein said creating said dual card includes at least one of: (1) embossing a magnetic stripe card with said account holder information and a dual card account identifier; and (2) storing information identifying said account holder and a dual card account identifier in a memory of a smart card.

However, the examiner takes Official Notice that it was old and well known at the time of this invention put account information on the magnetic stripe of credit cards.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Lilly, Fargo and Official Notice. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to modify existing lines of credit (Lilly, Para. 0001).

As per claim 18;

Lilly does not disclose:

The method of claim 1, wherein said dual card account has a dual card account identifier routable over both a private label network and a bankcard network.

However, the examiner asserts that it was old and well known in the art at the time of this invention to route transactions using co-branded cards differently depending on where the card is used. Evidence is provided in the disclosure of Strayer 2004/0054622 (Para's. 0034 and 0055).

Claims 35-37 are rejected under the same rationale used to reject claim 1 in conjunction with the claim to a computer readable medium including instructions executed by a processor according to Paragraphs 0033, 0034 and claims 34 and 44 of Lilly.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lilly et al. (2002/0156723) in view of The fight for retail credit Jason Fargo. Credit Card Management. New York: Dec 2000. Vol. 13, Iss. 9;, Official Notice and Steele et al. (2005/0021456 A1).

As per claim 6;

Lilly does not disclose:

The method of claim 5, further comprising: retrieving said non-monetary data from said second processing platform; and confirming with said account holder that said non-monetary data is accurate.

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However, Steele et al. discloses: (pg. 4, paragraph 0037) "In step 220, information is sent regarding the converted financial institution account to the customer. Information may be sent for the customer's review and also a confirmation from a customer may be required. The information may be forwarded to the customer in a number of ways, including, for example, email or regular mail".

Therefore it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Lilly, Fargo, Official Notice and Steele et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to provide security to the card holder and the issuer and prevent fraudulent activity.

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lilly et al. (2002/0156723) in view of Official Notice.

As per claim 32;

Lilly does not specifically disclose:

A method for operating a private label processing platform, comprising:
receiving, from a private label processing network, an authorization request, said authorization request including information identifying a transaction amount, a merchant, and an account identifier;
receiving an indication that an account holder agrees to terms associated with a dual card account;

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determining that said account identifier is an identifier of the dual card account;
extracting associated monetary and non-monetary data from a database associated with the private label processing platform in response to receiving an indication that the account holder agrees to the terms;
updating a cross-reference database table with the extracted associated monetary and non-monetary data, wherein the cross-reference database table is associated with both the private label processing platform and a dual card processing platform; and
forwarding said authorization request to a dual card processing platform for authorization.

However, Lilly discloses systems and methods for upgrading or modifying an existing credit card product with multiple lines of credit, where the main line of credit is a private label line of credit (Para. 0032). Additionally, a process is shown where a customer is presented an upgrade offer during a transaction process comprising the customer's agreement and authorizing the transaction according to either line of credit (Fig. 5B and Para's. 0081-0089).

With regard to the extraction of data and updating a dual card database, the examiner takes Official Notice that offers for credit extended during purchase transactions were old and well known in the art at the time of this invention. The examiner also asserts that it would have been obvious to extract data from the private label database as the customer is operating in the private label environment where the application is being processed. The store representative can either operate on the store's network and database or connect to the network and database of the issuer of

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the dual card account. As there are limited options, KSR rationale E would apply as it would be obvious to try when choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success.

Additionally, Lilly discloses updating a database to include the additional lines of credit associated with the dual card (Para. 0117).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Lilly and examiner's Official Notice.

One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to offer extensions of credit and efficiently process new credit card accounts to be used in transactions currently being processed.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lilly et al. (2002/0156723) in view of Official Notice and Roshkoff (2004/0254837).

As per claim 33;

Lilly does not disclose:

The method of claim 32, wherein said account identifier is associated with an inactive private label account, the method further comprising:
determining whether any trailing activity is associated with said inactive private label account..

However, Roshkoff discloses a marketing system where a previously inactive card is activated through a purchasing activity at a retail store or website (Para. 0059)

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and upon activation of the card offers are presented to the consumer (Para. 0029). Card usage is encouraged in order to track purchasing activity (Para. 0062).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Lilly, Official Notice and Roshkoff.

One of ordinary skill in the art at the time of this invention would have been motivated to do so for target marketing purposes (Lilly, Para. 0053).

6. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lilly et al. (2002/0156723) in view of Official Notice and Graves (6,575,361).

As per claim 34;

Lilly does not disclose:

The method of claim 32, further comprising:
determining that no stand in authorization rules apply to said authorization request prior to forwarding said authorization request.

However, Graves discloses processing of a purchase transaction where stand in authorization rules are not desired. The examiner notes that stand in authorization rules apply when the normal authorization channels or direct connections to the acquiring bank are down for maintenance or service outage, etc. These outages provide optimal opportunities for fraudulent or otherwise unacceptable transactions to proceed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Lilly, Official Notice and Graves. One of

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ordinary skill in the art at the time of this invention would have been motivated to do so in order to reduce the risk of approving transactions that would ordinarily be rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/

Supervisory Patent Examiner, Art Unit 3696

/William E Rankins/

Examiner, Art Unit 3696

06/30/2009